

**REMARKS**

Claims 15-22 are rejected under 35 U.S.C. §101 because the Examiner has deemed the claimed invention to be directed to non-statutory subject matter. Claims 15-22 are cancelled.

Claims 1, 2, 5, 6, 8, 9, 11-13, 15, 16, 18, 19, 20 and 22 are rejected under 35 U.S.C. §102(e) as being anticipated by *Elnozahy et al.* (U.S. 6,701,421).

Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Elnozahy et al.* patent must contain all of the claimed elements of claims 1 and 8. However, detecting a maximum number of nodes that may be coupled to the first node; and determining a size of the portion of the first memory in response to the maximum number of nodes, as claimed, are not shown or taught in the *Elnozahy et al.* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

Claims 1 and 8 include:

Claim 1. An information handling system comprising:

    a first node for:

        detecting a first memory in the first node;

        detecting a second memory in a second node coupled to the first node;

ensuring that a first set of contiguous addresses is mapped to a portion of the first memory, the first set of contiguous addresses each having a value lower than a four gigabyte address;

ensuring a second set of contiguous addresses is mapped to a portion of the second memory, the second set of contiguous addresses each having a value lower than the four gigabyte address;

detecting a maximum number of nodes that may be coupled to the first node; and

determining a size of the portion of the first memory in response to the maximum number of nodes.

Claim 8. A method comprising:

detecting a first memory in a first node;

detecting a second memory in a second node coupled to the first node;

ensuring that a first set of contiguous addresses is mapped to a portion of the first memory, the first set of contiguous addresses each having a value lower than a four gigabyte address;

ensuring a second set of contiguous addresses is mapped to a portion of the second memory, the second set of contiguous addresses each having a value lower than the four gigabyte address;

detecting a maximum number of nodes that may be coupled to the first node; and

determining a size of the portion of the first memory in response to the maximum number of nodes.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1 and 8 and their respective dependent claims are not anticipated by *Elnozahy et al.*

Claims 3, 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Elnozahy et al.* in view of *Intel Multiprocessor Specification Version 1.4*.

Applicants traverse this rejection on the grounds that the reference is defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present case, the references fail to teach detecting a maximum number of nodes that may be coupled to the first node; and determining a size of the portion of the first memory in response to the maximum number of nodes. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

A patent may be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 1 and 8 have not been met by the cited references, it is impossible to render the subject matter as a whole obvious. Thus the

explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The “difference” may have seemed slight (as has often been the case with some of history’s great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

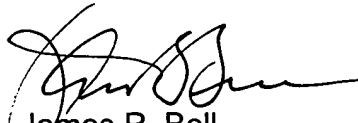
Therefore, independent claims 1 and 8 and the claims dependent therefrom are submitted to be allowable.

The Examiner has indicated that claims 7 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Therefore, the recitations of claims 7 and 14 are incorporated into their respective independent claims 1 and 8. Thus, claims 1-5 and 8-12 are submitted to be allowable.

New claims 23-27 are submitted for consideration and are deemed to be allowable. Applicants respectfully request consideration thereof.

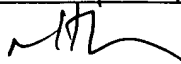
In view of the above, it is respectfully submitted that claims 1-5, 8-12 and 23-27 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

  
James R. Bell  
Registration No. 26,528

Dated: 6-18-04  
HAYNES AND BOONE, L.L.P.  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 512/867-8407  
Facsimile: 214/200-0853  
ipdocketing@haynesboone.com

A-162025\_1.DOC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
on	<u>6/18/04</u>
Date	<u></u>
Signature	<u>Nishi PASARYA</u>
Typed or Printed name of person signing Certificate	